

## **REMARKS**

### **Status of the Claims**

Claims 1 and 4-7 are pending in the present Application. Claims 4-6 have been withdrawn from further consideration. Claims 1 and 7 stand rejected. Reconsideration and allowance of all of the pending claims is respectfully requested.

### **Claim Rejections - 35 U.S.C. §103**

Claims 1 and 7 stand rejected under 35 U.S.C. §103(a) as unpatentable over JP 2002-121259 in view of Qi (U.S. 5,371,279), JP 5-140267 and Bolger (U.S. 5,840,417). For the following reasons, this rejection is respectfully traversed.

The final Office Action dated March 6, 2006 asserts that JP 2002-121259, unlike the present invention, discloses an equivalent addition of amine curing agent to epoxy resin. However the Office further contends that page 4, paragraph [0017] of the machine translation of JP 2002-121259 suggests that "as much as double the equivalent is acceptable if the property of the hardened material is not spoiled even if it is not desirable." See Office Action, page 4, section 6.

The Applicants provided evidence in the last Reply that paragraph [0017] of JP 2002-121259 does not say that "as much as double the equivalent is acceptable." The Applicants respectfully submit that the burden is upon the Examiner to establish what exactly the reference discloses. Generally speaking a machine translation cannot be properly relied upon to establish with any reasonable level of confidence what a reference discloses. In a recent decision by the PTO Board of Appeals and Interferences, the Board commented on a similar situation as follows:

In order to properly review the rejection it is of the utmost importance to have an English translation that reflects what is said in the original foreign document. Without such a translation, we cannot determine whether the underlying evidence supports the rejection. The computer generated translation falls short. A translation that reflects the disclosure of

the original Japanese document using proper English is required before we can review the rejection on appeal.

Board of Patent Appeals and Interferences, Appeal No. 2006-1122, Application No. 10/237, page 2. Accordingly, it is clear that the Office cannot rely upon a computer generated machine translation to support this rejection. To the extent that the rejection depends upon the computer translation, the Applicants respectfully request that it be withdrawn.

As discussed in the last Reply, the Applicants respectfully assert that paragraph [0017] of JP 2002-121259 generally discloses that an equivalent is preferred, although the amount may be off an equivalent as long as the properties are not compromised. The Applicants respectfully submit that if the Office wishes to assert that JP 2002-121259 discloses more than this, then a proper English translation of the document must be provided.

In any case, the Applicants herewith supply a verified English translation of paragraph [0017] of JP 2002-121259.

The Applicants herewith provide a **Declaration** by Kazuaki Sumita that clearly establishes that the properties of the presently claimed compositions are dependent upon the molar ratio of liquid epoxy resin (A) to aromatic amine curing agent (B). Table 1-1 shows that excellent properties are obtained when a molar ratio that is within claim 1 is used. Table 1-2 shows that the properties are compromised when a molar ratio outside the presently claimed range is used.

Accordingly, the Sumita Declaration establishes that JP 2002-121259 does not disclose or suggest "the liquid epoxy resin (A) and the aromatic amine curing agent (B) being present in a molar ratio (A)/(B) from 0.7/1 to less than 0.9/1" as presently recited in claim 1. Therefore all of the limitations of the present claims are not disclosed or suggested by the prior art, and the present claims are allowable.

In view of the Sumita Declaration, applicant believes that the pending application is in condition for allowance.

## Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact J. Mark Konieczny, Registration No 47,715 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: August 7, 2006

Respectfully submitted,

By J. M. Konieczny #47,715  
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Attachment: Declaration  
English translation of paragraph [0017] of JP 2002-121259



Docket No.: 0171-1077PUS1  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:  
Kazuaki SUMITA et al.

Application No.: 10/808,329

Confirmation No.: 5424

Filed: March 25, 2004

Art Unit: 1712

For: LIQUID EPOXY RESIN COMPOSITION AND  
SEMICONDUCTOR DEVICE

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Examiner: R. E. Sellers

**VERIFICATION OF TRANSLATION**

The undersigned hereby declares the following:

That I am knowledgeable in Japanese and English. That I have reviewed paragraph [0017] of JP 2002-121259 and verify that the following is an accurate translation thereof.

“[0017] The preferred curing agents used in the present invention are diaminodiphenylsulfone curing agents because they are effective in formulating thermosetting liquid resin compositions which can be B-staged. The amount of diaminodiphenylsulfone added is desirably equivalent to the total epoxy resin equivalent, but may be off the equivalent as long as cured resin properties are not compromised. However, it is undesired that the amount is too much off the equivalent, because the resin becomes undercured or the pot life and shelf life are impaired.”

All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true. Further, these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such

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willful false statements may jeopardize the validity of the application or any patent issued thereon.

August 7, 2006  
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Toyohiko Konno  
Toyohiko Konno